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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,208	07/25/2006	Yasuharu Ono	Q96004	7161
23373 7590 11/23/2010 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
BROWL, DAVID				
ART UNIT		PAPER NUMBER		
1617				
NOTIFICATION DATE		DELIVERY MODE		
11/23/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/587,208

**Applicant(s)**

ONO, YASU HARU

**Examiner**

DAVID M. BROWNE

**Art Unit**

1617

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 04 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 3 and 5-13.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Carlos A. Azpuru/  
Primary Examiner, Art Unit 1617

Continuation of 3. NOTE: Amendment introduces new claim limitations into and alters the scope of claim 1. Since these limitations were not addressed previously, further search and/or consideration of patentability would be required.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants should note that prosecution in this case is closed. Entry of a proposed amendment after final rejection cannot be made as a matter of right. The Examiner maintains the 35 USC 103 rejection of claims 1, 3, 6-11, and 13 as being unpatentable over Wong et al. (U.S. Patent No. 6,306,371) in view of Atsumi et al. (U.S. Patent No. 5,266,534) and Pratt et al. (U.S. Patent No. 4,849,223); and the 35 USC 103 rejection of claims 1, 5, and 12 as being unpatentable over Wong et al., in view of Atsumi et al., Niira, deceased et al. (U.S. Patent No. 4,938,955) and Ghosh et al. (U.S. Patent Application Pub. No. 2005/0227895), both of record.

Applicants arguments are based at least in part on the proposed claim amendment. However, as the proposed amendments have not been entered, the arguments are not found persuasive. Applicants other points have been fully considered as well, and are likewise not found persuasive:

i) Applicants assert that the imidazole based compound disclosed by Ghosh et al. is unsuitable for inclusion in applicants claimed invention, because the imidazole compound in Ghosh is polymeric, whereas applicants invention is directed to a silver-based inorganic antibacterial agent.

The Examiner, however, is not persuaded that the imidazole based compound of Ghosh is unsuitable. It is the silver ion based antibacterial agent that is inorganic, not applicants claimed composition. Thus, it is noted that applicants claimed composition can further include a acrylic acid or urethane based binder resin (claim 13).

ii) Applicants assert that Table 3 shows unexpected results, which overcomes the 103 rejections of record.

The Examiner, however, cannot agree. Table 3 shows that including two different discoloration inhibitors in the composition shows better effects that using either single discoloration inhibitor alone. This is not unexpected. It does not appear that applicants have shown that the combination has any synergistic effects superior to what would be expected from a combination of such agents.

For the aforementioned reasons, the 35 USC 103 rejections of claims 1, 3, and 5-13 of record are hereby maintained.

DMB